

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
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REMARKS

Claims 65-68 are pending in the subject application. Applicant has amended claim 65, canceled claim 66 and added claims 69-71 to more particularly point out what applicant regards as the invention. Support for amended claim 65 and new claims 69-71 is found *inter alia*, at page 8, lines 5-8, page 12, lines 11-15, page 20, lines 11-14 and Figures 1A, 1B and 8A of the application. Accordingly, claims 65 and 67-71 will be pending and under examination in the subject application upon entry of this Amendment.

Applicant respectfully requests that, in view of the remarks made herein, the Examiner withdraw the outstanding rejections.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 65-68 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that antibody binding can be either specific or non-specific in nature, with non-specific binding allowing the antibody to bind many additional proteins unrelated to PAK4. Applicant addresses the rejection as applied to amended claim 65, claims 67 and 68, and new claims 69-71.

In response to the Examiner's rejection, applicant respectfully traverses. Applicant points out that amended claim 65 and claims 67 and 68 provide an antibody which *specifically* binds to human PAK4 serine/threonine kinase and

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not to other proteins which are "unrelated" to PAK4. Likewise, new claims 69-71 provide an antibody which specifically binds to mouse PAK4 serine/threonine kinase, and not to other proteins which are unrelated to PAK4.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, second paragraph.

Rejections under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 65-68 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner stated that applicant has claimed the broad genus of antibodies that bind PAK4 derived from any mammal when only the species of a complete human sequence and a partial mouse sequence are disclosed. Applicant addresses the rejection as applied to newly amended claims 65, 67 and 68, and new claims 69-71.

In response to the Examiner's rejection, applicant respectfully traverses. Applicant again notes that claim 65, as amended, and claims 67 and 68 provide an antibody capable of specifically binding to *human* PAK4, and new claims 69-71 provide an antibody capable of specifically binding to *mouse* PAK4. The claims do not encompass antibodies that bind PAK4 derived from any and all mammals.

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In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

Rejections under 35 U.S.C. §101

The Examiner rejected claims 65-68 under 35 U.S.C. §101, as allegedly directed to non-statutory subject matter. Specifically, the Examiner stated that an antibody that binds PAK4 can be found in nature, such as in the serum of a non-immunized animal. Applicant addresses the rejection as applied to amended claim 65, claims 67 and 68, and new claims 69-71.

In response to the rejection, applicant respectfully traverses. Applicant points out that the claims all provide *purified* antibodies, thereby encompassing subject matter not occurring in nature.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §101.

Rejections under 35 U.S.C. §102(e)

The Examiner rejected claims 65-68 under 35 U.S.C. §102(e), as allegedly anticipated by Plowman et al., U.S. Patent Application Publication No. US 2003/0050230 ("Plowman"). Specifically, the Examiner stated that as all 398 amino acids of PAK5 disclosed by Plowman are contained in the PAK4 of the instant application, an antibody that specifically binds to

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the PAK5 of Plowman would necessarily bind to PAK4 of the instant application. Applicant addresses the rejection as applied to amended claim 65, claims 67 and 68, and new claims 69-71.

Under 35 U.S.C. §102, and as stated in M.P.E.P. §2131.01, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added). Hence, to anticipate the antibodies of claims 65 and 67-71, Plowman would have to teach each and every element thereof.

Plowman fails to do this.

Plowman discloses antibodies capable of *specifically* binding to PAK5 while the instant claims are directed towards antibodies capable of *specifically* binding to human and mouse PAK4. Plowman fails to teach antibodies that *specifically* bind to PAK4. Therefore, Plowman fails to teach each and every element of the claimed invention and does not anticipate the claimed invention.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §102(e).

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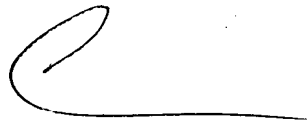
Summary

Applicant maintains that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

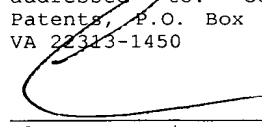
No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450


Alan J. Morrison
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1/28/05
Date